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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FULBRIGHT & JAWORSKI, LLP			EXAMINER	
1301 MCKINNEY			SAYALA, CHHAYA D	
SUITE 5100				
HOUSTON, TX 77010-3095			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			06/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/540,095

**Applicant(s)**

HALL, SIMON REGINALD

**Examiner**

C. SAYALA

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/27/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1      Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/97605 and WO 01/97630 in view of Foreman et al. (US Pub. 2001/0048955) taken with Jewell et al. (US Patent 6410063), and further in view of Romsos et al. (JAVMA, vol. 182(1), pp. 41-43, 1983) and Wills, Josephine ("Adult Maintenance", BSAVA Manual of Companion Animal Nutrition & Feeding, Chapter 3, British Small Animal Veterinary Association 1996, pages 44-46).

Applicant's claims include providing several food compositions that are "different and preferred quantities" to cats, dogs, horses, fishes and birds (claim 8) over an "extended and preselected period of time", that provides fat, protein and carbohydrate, allowing these animals, birds and fishes to consume these foods over this preselected time period and determining a customized dietary regime from the consumed amounts of fat, protein and carbohydrate and based on providing the optimum macronutrient content. Claim 4 recites a "learning phase" of 3 days or more within the time period recited in claim 1. Claims 5-7 recite amounts of protein, fat and carbohydrate in the

offered food compositions. It is being assumed that these amounts of macronutrients further define the "preferred quantities" and the ranges provide the "different" quantities. "Extended and preselected" periods of time include a "learning phase" which is not defined in the specification, but for examination purposes has been given the description at page 5, which is offering a single diet composition at any one feeding "experience". The learning phase therefore reads on offering "the enriched" single food composition for an undefined period of time that is 3 days at least, during which period the bird, fish, cat, dog or horse is "learning" to eat.

The WO '605 patent discloses feeding one food in the morning and one food in the evening, i.e. different food compositions, with different nutrient profiles or different contents of fat, protein and carbohydrates. Example 1 shows that 3 diets with different levels of macronutrients were offered in rotation for 30 days. A macronutrient preference by the animal was obtained. Amounts of protein varied between 10 to 70% and fat from 30-90%. Example 3 shows that the food was offered in 5 different diets. This data therefore suggests offering protein and fats in diets that are similar to the instantly claimed 5 and 6 in order to study the macronutrient preference to formulate a dietary regime for the animal, based on consumption. Note that the extent of time in this study discloses that the period of time was "extended and preselected". The patent does disclose a preference of one type of macronutrient over another for different times of the day, thus suggesting that an optimum macronutrient requirement can be determined for the animal. See the conclusions stated at the Examples.

The protocol stated in the WO '630 patent is similar to the WO '605 patent and provides a macronutrient diet that has between 20-75% fat and at least 25% protein. See page 4. Different diets were offered over a preselected and extended period of time, according to the Examples, in order to determine the macronutrient preference for different times of the day. The patent also teaches that these studies can be conducted to determine the physiological needs for any undefined "event", such as a time of stress, of a particular part of the year or week. See page 2. Claim 3 is disclosed at page 4, line 11.

Thus these patents teach offering different food compositions with differing macronutrient contents so that the animal can consume whatever is needed according to its physiological response or need (abstract WO '630), and by offering such diets over an extended and preselected period of time, determining a dietary regime for the animal based on the macronutrient preference by that animal. The patent teaches that it was determined that animals ate a higher protein macronutrient content in the morning and had a higher fat preference in the evening, and a dietary regime was determined based on these results. See page 3, last paragraph and page 4, first paragraph. Claim 3 is disclosed at page 5, line 4.

The two patents do not show the carbohydrate content as in instant claim 7, although they show varying the carbohydrate content in conjunction with protein and fat. The patents do not teach a "learning phase".

With regard to amounts of macronutrients claimed herein, Foreman et al. teach offering a variety of foods to pets and teach a nutrient composition of protein 5-60%, fat

1-50% and carbohydrate or fiber of 1-60%. See paragraph [0032]. At col. 2, lines 23+, Jewell et al. teach a diet that contains 0-about 20% carbohydrate, 25-70% protein and 20-70% fat. Both the WO patents claim a diet for a pet that contains 20-70% fat and at least 25% protein. Based on such, it would have been obvious to provide a carbohydrate content as disclosed by the above Foreman and Jewell patents that show these to be beneficial.

As for the "learning phase", Rosmos et al. disclose that animals such as rats and dogs are able to self-select the diet and are able to regulate their protein and energy intake by self-selection when allowed free-choice feeding. The dogs under this study were able to choose between 2 diets that differed in protein content, and regulate their protein intake and establish a pattern within a week of the 4-week study. While Rosmos indicates a week to regulate their diet and applicant claims "3 days or more" of a learning period, it is not clear if this difference can be considered to be of a patentable distinction since dogs, cats, fishes and birds have different learning abilities. Also, if the food containing the carbohydrate, fat and protein contents as shown by the primary references were to be offered in a free-choice feeding method so that the dogs are able to self-regulate not just the protein content but also the fat and carbohydrate content, then it can be reasonably expected that they would have developed a pattern with these macronutrients too, not just protein and regulated their macronutrient content with respect to carbohydrate and fat also, thus exhibiting a "learning phase" for such macronutrients too. Based on this to determine a macronutrient preference and to formulate a dietary regime would have required no more than ordinary skill.

The reference of Wills teaches that cats often detect nutritional deficiencies in their diets and have the ability to reject such diets, thus showing that animals opt for diets that complete in the nutrients they need. The reference also states that dogs are able to become accustomed to meal times and places where they eat. Therefore, although the reference does not call this a "learning phase", it does establish that cats and dogs are a quick study or animals of habit, and learn fast enough about meals and places and this fact taken with the disclosure of Romsos which describes that the dogs established a pattern within a week with regard to regulating their protein intake, one of ordinary skill in the art would have reasonably expected such a pattern to be established in feeding the diets of the primary references as well, thus meeting claim 4. To incorporate a "learning phase" therefor, would not have required more than ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments filed 2/17/2009 have been fully considered but they are not persuasive.

Applicant's remarks have been made in the context of the amended claims. Nonetheless, they will be addressed as much as they apply to the rejection as made above to meet the newly amended claim 1. At the outset, it should be noted that with regard to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has criticized Foreman for not disclosing the animal selecting its food for over an extended and preselected period of time. See page 7 of the remarks. Jewell is also criticized for the same "shortcomings". Upon review, it will be clear that these two references reiterate the limitations of instant claims 5-7 and the teachings of the two WO patents. Although these patents teach varying macronutrient contents in the various compositions that were offered to the animals, they do not specifically teach the carbohydrate content, which the secondary references show as being already used in the art.

With regard to the WO patents, applicant states that these patents teach offering one pet food in the morning and one in the evening. One was high in protein and one high in fat. This is incorrect. The Examples of both patents show that 3 diets or 5 diets with "different levels of the macronutrients protein and fat" and the diets were rotated over a 30-day period so that the animal received one diet per day. There is no stipulation in the claims that such a protocol should be excluded. On the other hand, the 30-day period provides the "extended and preselected period of time". Even if the reference is interpreted as applicant has, the study still provides insight to one of ordinary skill in the art of the following: offering the animal a variety of diets of different macronutrient contents (page 8, line 25), determining the animal's preference for the variety of macronutrients offered based on what it consumes, (Figs. 2-3) and formulating a dietary regime for the animal based on this (page 7, lines 8-11). See *In re*



*Hoeschele*, 406 F.2d 1403, 1406-07 (CCPA 1969)("[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom...").

The Rosmos and Wills references have been used to show that animals needed time to regulate their self-selection process, which is assumed to be the "learning phase" described by applicant in his specification. It is being surmised that the "learning phase" teaches the animal to eat a variety of macronutrient contents or to self-select or to self-regulate. In any event, the two references clearly suggest such a phase and are being used for such teachings only. Therefor to incorporate such a [hase in the primary references would not require more than ordinary skill.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/  
Primary Examiner, Art Unit 1794**

